

REMARKS

In the above referenced case, claim 132 is pending.

I. The 35 U.S.C. §103 Rejection

Claim 132 was rejected under 35 U.S.C. §103(a) as being unpatentable over Nicolas et al., U.S. Patent No. 5,299,036 (“NICOLAS”) in view of Miyatake et al. (“MIYATAKE”), U.S. Patent No. 4,943,154 and of Konno et al., U.S. Patent No. 4,497,015 (“KONNO”). Applicant respectfully traverses the rejection.

The Examiner relied on KONNO for allegedly disclosing element [a], on NICOLAS for allegedly disclosing elements [b]-[f], and MIYATAKE for allegedly disclosing element [g] of claim 132.

Applicant respectfully submits that the combination of KONNO with NICOLAS and MIYATKE is improper for the reasons set forth below.

A. KONNO Is Non-Analogous Art

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP 2141.01 (a).

1. KONNO Is Not in the Same Field of Endeavor as the Present Application

Claim 132 recites a projection apparatus for displaying an image. In contrast, KONNO discloses technology relating to photolithography in semiconductor manufacturing processes. KONNO, col. 1, lines 6-10. Technology relating to projection of images onto a screen viewable by humans is not in the same field of endeavor as technology relating to semiconductor manufacturing processes.

2. KONNO Is Not Reasonably Pertinent to the Particular Problem with which the Inventor Was Concerned

Claim 132 recites a projection apparatus for displaying an image. One of the problems being addressed by this claim relates to the efficiency of light transmission to light altering means (e.g., liquid crystal devices). In contrast, KONNO addresses the problem relating to fine circuit pattern resolution on a semiconductor substrate. KONNO, col. 1, lines 12-17. Thus, KONNO does not address problems reasonably pertinent to the particular problems dealt with by claim 132.

Based on the foregoing, KONNO is non-analogous art and should not have been cited in combination with NICOLAS and MIYATAKE to reject claim 132.

B. There Is No Motivation to Combine KONNO with NICOLAS and MIYATAKE

Even if KONNO is properly cited, there is no motivation to combine KONNO with NICOLAS and MIYATAKE.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.” MPEP 2143.01. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Id.

NICOLAS discloses an image projector for producing enlarged images for viewing on a projection screen.

The enlargement of this optical conjugation is such that IS'1 and IS'2 are entirely inscribed within the aperture of the projection objective LP. NICOLAS, col. 5, lines 36-38 (emphasis added).

Similarly, MIYATAKE discloses a projection display apparatus for producing enlarged images for viewing on a projection screen.

An enlarged image of the color picture is finally projected by the projection lens 65 on a screen 66. MIYATAKE, col. 6, lines 20-22 (emphasis added).

In contrast, KONNO discloses an optical system for producing a reduced image to be printed on a wafer.

FIG. 1A illustrates the arrangement of optical members of a reduced-projection exposure system for printing on a wafer a reduced image of a circuit pattern drawn on a photomask or reticle. KONNO, col. 2, lines 44-47 (emphasis added).

Based on the foregoing, there is no motivation to combine KONNO with NICOLAS and MIYATAKE and claim 132 should be in condition for allowance.

C. KONNO Teaches Away from NICOLAS and MIYATAKE

Further, KONNO, NICOLAS and MIYATAKE teach away from their combination.

"It is improper to combine references where the references teach away from their combination." MPEP 2145. NICOLAS and MIYATAKE both disclose a projection system for producing enlarged images for viewing on a projection screen. In contrast, KONNO discloses an optical system for producing reduced images to be printed on a wafer. These references teach away from each other and their combination is therefore improper.

D. Conclusion


Based on all of the foregoing, Applicant respectfully submits that the combination of KONNO with NICOLAS and MIYATKE was improper. Therefore, claim 132 is not unpatentable over these references.

II. Conclusion

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance. Should the Examiner believe that a telephone interview would help advance the prosecution of this case, the Examiner is requested to contact the undersigned attorney.

Respectfully submitted,

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